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10/803,025	03/18/2004	Ying-Chang Chen	BHT-3249-10	5614

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TROXELL LAW OFFICE PLLC
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EXAMINER

HAMILTON, ISAAC N

ART UNIT	PAPER NUMBER
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3724

MAIL DATE	DELIVERY MODE
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05/10/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/803,025

Applicant(s)

CHEN, YING-CHANG

Examiner

Isaac N. Hamilton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-14 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-14 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 February 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: Figure 9, "lover" should be changed to --lower-- in the box of the third column, second row.

Appropriate correction is required.

Claim Objections

2. Claim 4 is objected to because of the following informalities: "a first and a second plates, and the first and the second cutters are mounted on and move with the first and the second plates" should be changed to --first and second plates, and the first and second cutting members are mounted on and move with the first and second plates--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1, 4-14 and 21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 1 and 21 recite that "holding member fixedly positioning the plastic lens in a second direction perpendicular to the first direction" however, the holding member has guide posts 32 as shown in figure 3, which guide the holding member in the same direction as the first and second cutters. How does the holding member move in a second direction different

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from the first direction if the guiding posts of the cutting member and the guiding posts of the holding member are parallel as shown in figure 3?

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 4-6 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Kohama et al (4,660,401), hereafter Kohama. Kohama discloses first direction in the vertical direction in figures 1, 2 and 14; first cutter 106; second cutter 126; the first cutter first contact the workpiece in the first direction when elements 101, 106 and 108 are moved simultaneously into contact with workpiece 129; the second cutter cooperates with the first cutter to cut the workpiece as shown in figure 2; the apparatus in the figures is capable of cutting a plastic lens, and is capable of cutting an injection molded resilient product, wherein the resilient product is connected with at least one carrier to be removed therefrom; second direction is the horizontal direction as shown in figures 1, 2 and 14; holding member 131; the second direction is perpendicular to the first direction; first plate 114; second plate 123; cylinder 10; piston 17; base 128; guiding posts 17; power source is the press machine recited in column 15, line 45; the first time is when first cutter 106 contacts the workpiece; the second time is when the second cutter contacts the workpiece; the first time is earlier than the second time because first cutter must contact the workpiece simultaneously with element 108, which then forces element 115 to be depressed and allow the second cutter 126 to finally contact the workpiece.

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7. Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Kugler (2,526,955). Kugler discloses cutting member shown in figure 1; first cutter 6; second cutter 7; first direction is the vertical direction in figures 1-7; the first cutter is capable of first contacting the workpiece in the first direction by contacting the workpiece prior to the second cutter contacting the workpiece; the cutting member is capable of cutting a plastic lens and is capable of cutting an injection molded resilient product, wherein the resilient product is connected with at least one carrier to be removed therefrom; holding member 10, 11; second direction is the horizontal direction in figures 2, 4 and 5-7; first plate 4; second plate 5.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1, 4-13 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Waltonen (Re. 33,798) in view of Sartorio (5,894,754). Waltonen discloses cutting member in figure 1; first direction is the horizontal direction as shown in figure 2; first cutter 26; second cutter 22; first and second cutters are moved away and toward each other as shown in figure 2 by the phantom lines; the first cutter 26 contacts the workpiece 36 in the first direction as shown in figure 2; second cutter 22 cooperates with first cutter 26 to cut the workpiece; first plate 34; second plate 20; piston 24; cylinder 12; base 10; guiding posts in figure 5 juxtaposed elements 68 and 70; the first cutter is capable of contacting the workpiece before the second cutter when the workpiece is positioned closer to the first cutter initially; stopper 62; resilient component/spring

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64 and 66; power source is recited in column 3, line 34; the apparatus is capable of cutting an injection molded resilient product; the workpiece 36 is inserted into the cutting device in a second direction perpendicular to the first direction as shown in figure 2.

Waltonen discloses everything as noted above, but does not disclose a holding member, a movable holding plate, guiding posts, a holder, a recess, and does not disclose that the holder is exchangeable. Sartorio teaches holding member 64; movable holding plate 66; guiding posts 70, 72; exchangeable holder 98; and recess 104. It would have been obvious to provide a holding member, a movable holding plate, guiding posts, an exchangeable holder, and a recess in Waltonen as taught by Sartorio in order to position the workpiece at different positions. Note that holder 98 is exchangeable due to shank 106 and groove 114.

10. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Waltonen and Sartorio, as applied to claims 1, 4-13 and 21 above, and further in view of Johnson (4,449,434). The combination discloses everything as noted above, but does not disclose heaters. Johnson teaches heaters in the abstract. It would have been obvious to provide heaters in the combination as taught by Johnson in order to reduce the amount of ware to the punch and die while cutting thermoplastic materials.

Response to Arguments

Applicant's arguments filed 02/23/07 have been fully considered but they are not persuasive.

Applicant asserts that Kohama fails to disclose a first cutter **first** contacting the workpiece in the first direction, a second cutter **then** cooperating with the first cutter to cut the

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workpiece completely in the first direction, and a holding member **fixedly positioning** the plastic lens in a second direction perpendicular to the first direction.

Regarding a first cutter first contacting the workpiece in the first direction, in column 15, lines 58-61, Kohama discloses that upper die half 108 moves first so that bottom surface 109 contact the workpiece. As shown in figure 1, the cutting edge 107 of first cutter 106 is coplanar with the bottom surface 109 of the upper die half 108. Therefore, when bottom surface 109 first contacts the workpiece, first cutter 106 also contacts the workpiece. No cutting occurs in Kohama until after first cutter 106 contacts the workpiece when die half 115 is depressed and second cutter 126 then cooperates with first cutter 106 to cut the workpiece completely in the first direction as recited in the claim limitations.

Regarding the holding member of Kohama, applicant asserts that holding member 131 of Kohama is adapted to feed the workpiece 129 in the horizontal direction perpendicular to the cutting direction, but does not act as a holding member as claimed. However, the cutting direction is considered to be the first direction and the horizontal direction is considered to be the second direction, which is perpendicular to the second direction. Moreover, holder member 131 feeds the workpiece a predetermined amount so that the workpiece is fixedly positioned between first cutter and the second cutter in order to position the workpiece in the desired position for cutting. The holding member 131 of Kohama meets the claim limitations and anticipates the claimed structure.

Applicant asserts that Kugler does not disclose that first cutter 6 does not first contact the workpiece before second cutter 7 in a first direction, and asserts that holding member 10, 11 does not fixedly position the workpiece in a second direction perpendicular to the first direction.

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However, since Kugler is a hand-held device a user is capable of manipulating the tool in several different ways in order to cut through workpiece. For instance, if a user first contacted the workpiece with first cutter 6 in order to stabilize the cutter relative to the workpiece before activating the second cutter 7 to cut the workpiece in the first vertical direction, then Kugler meets the claim limitations. Moreover, holding member 10, 11 is capable of fixedly positioning the workpiece in a second direction perpendicular to the first direction if the user moved the cutting device perpendicular to the surface of holding member 10, 11 in order to position the workpiece juxtaposed first cutter 6.

Applicant asserts that Waltonen does not disclose a first cutter and a second cutter because Waltonen is a punching device, however, punches and dies are considered to be cutting tools. Therefore, punch 26 is considered to be the first cutter, and punch die button 22 is considered to be the second cutter.

Applicant also asserts that Waltonen is silent on whether punch 26 contact the workpiece before the punch die button 22, thus further asserting that Waltonen does not disclose a first cutter first contacting the workpiece a the first direction and a second cutter then cooperating with the first cutter to cut the workpiece. However, as stated in the rejection above, the first cutter is capable of contacting the workpiece before the second cutter when the workpiece is positioned closer to the first cutter initially.

Finally, it was never stated that Waltonen discloses a holder member. Sartorio teaches a holder member, and was combined with Waltonen in both the previous and present Office letter. Applicant's assertion that Waltonen does not disclose a holder member is therefore considered moot.

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Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isaac Hamilton whose telephone number is 571-272-4509. The examiner can normally be reached on Monday through Friday between 8am and 5pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer D. Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



IH

May 8, 2007


KENNETH E. PETERSON
PRIMARY EXAMINER